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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,390	05/31/2001	Daniel A. Maude	CAO-0090	9880

7590

09/13/2002

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EXAMINER

EVANISKO, LESLIE J

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 09/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,390

Applicant(s)

MAUDE ET AL.

Examiner

Leslie J. Evanisko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-5. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 12-26 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the apparatus claims drawn to the earplug closely correspond to the process claims. This is not found persuasive because of the following reasoning: The application contains claims to both a process of making and a product made. Again, the MPEP states in 806.05(f) that "a product defined by the process by which it can be made is still a product claim" and is restrictable from the process if the examiner can demonstrate that the product can be made by another materially different process. Thus, it is noted that the product claim merely recites an earplug having a surface with a pattern formed thereon. It is the Examiner's position that the product as claimed can be made by another and materially different process, such as one including making a pattern by embossing or by painting or coloring by hand.

In view of the above reasoning, the requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no

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allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the printing device being an impact type printing device as recited in claims 15-16 and the plurality of printing devices oriented as recited in claims 20-21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The abstract of the disclosure is objected to because it uses improper abstract language such as "The present invention provides...". Correction is required. See MPEP § 608.01(b).

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

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The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. **It should avoid using phrases which can be implied**, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

6. Claims 12-26 are objected to because of the following informalities: With respect to claim 12, since claim 20 recites a plurality of printing device, it is suggested that the term "a" in line 4 be deleted and replaced with --at least one-- to insure it is clear that claim 20 is further limiting claim 12 rather than improperly modifying it. Similarly, it is suggested that claim 20 be amended to use language such as the following: --wherein the at least one printing device comprises a plurality of printing devices.--

With respect to claim 15, the term "the foam body" has no proper antecedent basis since no foam body was previously recited. To correct this problem, it is suggested that the term "the foam body" be deleted and replaced with --the earplug surface-- or similar language. Additionally, the term "type" is improper and indefinite claim language as set forth in MPEP 2173.05(b)(E) since it is unclear what the term "type" is intended to convey. To correct this problem, it is suggested that the term "type" be deleted from the claim.

With respect to claim 17, the term "the ink jet printing device" has no proper antecedent basis because no ink jet printing device was previously recited in the parent claim. To correct this problem, it is suggested that claim 17 be amended to depend upon claim 13, which recites the ink jet printing device. In an effort to advance prosecution, the Examiner has assumed this is the case.

With respect to claim 21, note that this claim improperly depends upon itself. To correct this problem, it is suggested that claim 21 be amended to depend upon claim 20. In an effort to advance prosecution, the Examiner has assumed that claim 21 is intended to depend upon claim 20.

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12-14 and 17-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egosi (US 4,843,958) in view of either of McLean (US 4,052) or Merritt (Des. 349,571). Egosi teaches a method of applying a coating to an object **E** with a curved surface (such as an egg) including the

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steps of providing the object, orienting the object relative to a printing device

56, 56a-56f, and printing a pattern on the object using the printing device.

See, in particular, Figures 1 and 12-17 and column 4, lines 23-28 and columns

9-10. Although Egosi does not necessarily teach printing upon an earplug,

note each of Mclean and Merritt teach an earplug having a printed design

thereon is well known in the art. See, in particular, the Figure of Merritt and

Figures 1-3 and column 2, lines 46-50 of McLean. In view of this teaching, it

would have been obvious to one of ordinary skill in the art to provide the

printing process of Egosi to be used to print upon a surface of an earplug since

McLean and Merritt teach that printing upon earplugs is well known in the art.

With respect to claims 13-14 and 17, note Egosi teaches the use of a non-impact printing device (i.e., ink jet printer) in column 4, lines 23-28.

With respect to claims 18-19, note that Egosi teaches the desire to have colored images, printed text, and/or advertising information in column 1, lines 34-37 and column 3, lines 50-66.

With respect to claim 20, note that Egosi teaches the use of a plurality of printing devices as recited. See, for example, Figure 2.

With respect to claim 21, although Egosi does not necessarily teach the particular arrangement of the printing devices as recited, note there is no unobviousness in arranging printing devices in any desired arrangement (such as at 120, 180, or 90 degrees relative to each other) in order to provide a simpler mechanism for printing around the circumference of the object.

With respect to claims 22-23, note Egosi teach an alignment device **216** for positioning the object within or near the printing device **56, 56a-56f** and selectively positioning the object in a plurality of orientations during printing. See, for example, Figures 12-17 and column 10, lines 29-68.

With respect to claims 24-26, note Egosi teach the printing device including at least one nozzle and is associated with a microprocessor and computer unit to allow the printing device to apply the pattern to the object from a plurality of positions and orientations. See, in particular, Figures 11-17 and column 3, lines 55-58 and column 9, lines 54-60.

9. Claims 12-15, 18-20, and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Ackley (US 5,655,453) in view of either of McLean (US 6,364,052) or Merritt (Des. 349,571). Ackley teaches a process of applying a pattern to an object with a curved surface (such as a pellet or other cylindrical shaped object) including the steps of providing the object, orienting the object relative to a printing device, and printing a pattern on the object using the printing device. See, in particular, Figures 2 and 15 and columns 8-12.

Although Ackley does not necessarily teach printing upon an earplug, note each of Mclean and Merritt teach an earplug having a printed design thereon is well known in the art. See, in particular, the Figure of Merritt and Figures 1-3 and column 2, lines 46-50 of McLean. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the printing process

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of Ackley to be used to print upon a surface of an earplug since McLean and Merritt teach that printing upon earplugs is well known in the art.

With respect to claims 13-15, note Ackley teaches the use of a non-contact printing device (i.e., ink jet printhead) and an impact printing device in column 9, lines 57-66 and column 12, lines 29-48.

With respect to claims 18-20, note the teaching in column 6, lines 27-30 and column 8, lines 34-39 of Ackley.

With respect to claim 22, note the object of Ackley is oriented by an alignment device **10, 12, 25** for positioning the object within or near the printing device.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ackley in view of either of McLean or Merritt as applied to claims 12-15, 18-20, and 22 above, and further in view of Roulleau (US 5,142,976). Ackley in view of either McLean or Merritt teach a process as recited with the exception of the particular type of contact printing device. Roulleau teaches that the use of an impact printing device such as a pad printing device for printing upon curved surfaces is well known in the art. See columns 1-2 and Figure 1 of Roulleau in particular. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a pad printing device as taught by Roulleau in the printer of Ackley as modified by McLean or Merritt as it would simply

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require the obvious substitution of one known impact printing device for another.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weber et al. (US 5,931,166), Carlson (US 5,831,641), Bennett (US 5,144,330), and Nakanishi (JP 5-293955) each teach an ink jet printing process for printing upon curved surfaces of objects. Tamura (JP 62-99186) teaches a pad printing process for printing upon curved surfaces of an object. Zillinger (DE 200 06 593 U1) teaches an earplug including advertising information having obvious similarities to the claimed subject matter.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(703) 308-0786**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Leslie Evanisko
Leslie J. Evanisko
Primary Examiner
Art Unit 2854

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lje

September 9, 2002